

Appl. No. : 10/563,621  
Filed : April 17, 2006

### REMARKS

#### Request for Entry of Amendments

Claim 1 has been amended to merely clarify that the aluminum sulfate is added to the papermaking pulp. Support can be found in the section of "Manufacturing of Newsprint Base Paper" at page 18, line 18 to page 19, line 14, for example. Claims 1 and 12 have been amended to include the features of Claim 19, and Claim 19 has been canceled. No new matter has been added. No new issue has been raised with regard to Claims 1 and 12 because the scope of amended Claims 1 and 16 are substantially unchanged relative to previously pending and now canceled Claim 19. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks. Applicants believe that entry of the amendment would place the application in better condition for allowance or appeal.

#### Rejection of Claim 1 Under 35 U.S.C. § 112

Claim 1 has been rejected under 35 U.S.C. § 112, second paragraph, asserting that it is unclear to what the aluminum sulfate is added, i.e., to the papermaking pulp or to the sizing agent. Claim 1 has been amended to clarify that the aluminum sulfate is added to the papermaking pulp, thereby obviating this rejection.

In the section of Response to Arguments, the Examiner asserts that the arguments are not persuasive because they are narrower than the claims, and the remarks show a table showing unexpected results and while that might be true, those unexpected results are for specific ratio of the components and the claims are not limited by any amounts.

Claims 1 and 12 have been amended to recite, among other things, the feature "a ratio by solid weight of the styrene monomer of component (a) to the cationic monomer of component (b) is in the range from 80:20 to 20:80." The significance of the ratio is described in the specification (see page 13, lines 5-14, for example). In the claimed invention as defined in Claims 1 and 12, although base paper for newsprint has a low aluminum sulfate addition ratio, water absorption resistance becomes significantly high by using a specific sizing composition. Table 1 on page 26 illustrates such unexpected results which can be obtained when:

- 1) the cationization degree of the water-soluble surface sizing agent is 1.3-3.0 meq/g;
- 2) the average particle size of the water-soluble surface sizing agent is 40 nm or smaller;

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- 3) aluminum sulfate is added at a ratio of less than 3.0% by weight relative to oven-dried pulp when manufacturing the base paper for newsprint; and
- 4) a ratio by solid weight of the styrene monomer of component (a) to the cationic monomer of component (b) is in the range from 80:20 to 20:80.

It is surprising that the newsprint paper having a low aluminum sulfate addition rate, as defined above and in Claims 1 and 12, has high water absorption resistance. The claimed invention provides an unpredictable solution to the problem where a newsprint paper having a low aluminum sulfate (neutral newsprint paper) has poor water resistance. There is no identified problem in the prior art, and there is more than "a finite number of identified, predictable solutions." See *Eisai Co. Ltd. v. Dr. Reddy's Laboratories, Ltd.*, 87 USPQ.2d 1452, 1457, 533 F3d 1353 (Fed. Cir. 2008) (To the extent an art is unpredictable, as the chemical arts often are, *KSR's* focus on these "identified, predictable solutions" may present a difficult hurdle because potential solutions are less likely to be genuinely predictable.)

In view of the foregoing, the claimed invention as defined in Claims 1 and 12 as amended herein could not be *prima facie* obvious over Koji et al, Yuji et al, or Noriaki. This determination is supported by the unexpected results based on the applicants' examples commensurate in scope with Claims 1 and 12. Claims 16-23 also could not be obvious at least due to their dependencies from Claim 1 or 12, in addition to the other distinguishing features recited therein.

Applicants respectfully request withdrawal of the rejection.

#### No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

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**CONCLUSION**


In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. The grounds for rejection which are not discussed herein are moot and Applicants expressly do not acquiesce in the findings not separately addressed. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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